Internal distribution code:

(A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [X] To Chairmen
(D) [-] No distribution

Datasheet for the decision of 20 April 2023

Case Number: T 0558/20 - 3.3.10

Application Number: 11734215.4

Publication Number: 2588154

IPC: A61L24/00, A61L24/02, A61L27/12, A61L27/58

Language of the proceedings: EN

Title of invention:
COMPOSITION COMPRISING CALCIUM PHOSPHATE, SULFATE POWDERS OR DMB USED IN THE TREATMENT OF DEGENERATIVE BONE CONDITIONS

Patent Proprietor:
Agnovos Healthcare, LLC

Opponent:
Bone Support AB

Headword:
BONE REGENERATION / Agnovos

Relevant legal provisions:
EPC Art. 53(c), 54(5), 56

Keyword:
Novelty - novelty of use - second (or further) medical use - main request (no) - auxiliary request (yes)
Method steps as limiting features of the claim (yes)
Inventive step - auxiliary request (yes) - non-obvious solution

Decisions cited:
G 0002/08

Catchword:
On the assessment of novelty under Article 54(5) EPC (point 2 of the reasoning), in particular when a claim defines a combined surgical and therapeutic method (points 3.2 and 5 of the reasoning)

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0558/20 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 20 April 2023

Appellant: (Patent Proprietor)	Agnovos Healthcare, LLC 7301 Calhoun Place, Suite 100 Rockville, MD 20855 (US)
Representative:	Hoffmann Eitle Patent- und Rechtsanwälte PartmbB Arabellastraße 30 81925 München (DE)
Respondent: (Opponent)	Bone Support AB Scheelevägen 19 Ideon Science Park 223 70 Lund (SE)
Representative:	Guardian IP Consulting I/S Diplomvej, Building 381 2800 Kgs. Lyngby (DK)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 7 January 2020 revoking European patent No. 2588154 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	A. Zellner
Members:	M. Kollmannsberger
	F. Blumer

Summary of Facts and Submissions

I. The patentee's appeal lies from the decision of the Opposition Division to revoke European Patent 2 588 154 pursuant to Articles 101(2) and 101(3)(b) EPC.

II. The patent had been opposed under Articles 100(a)(b)(c) EPC for lack of novelty and inventive step, insufficient disclosure and unallowable amendments.

III. The following documents are referred to in this decision:

D3: S.R. Murali et al., "New bone formation in an osteoporotic patient treated by intraosseous injection of bioactive materials; a case report"; Cells and Materials 4(4), 337-346 (1994)

D9: Declaration by Prof. Einhorn, 12 January 2016

D11: Declaration by Dr. Diefenbeck, 11 July 2018

D27: Declaration by Prof. Burr, 5 November 2018

D29: Declaration by Prof. Einhorn, 29 November 2018

D31: Declaration by Dr. Diefenbeck, 10 October 2019

D33: WO 95/27518 A

D34: Press release dated 3 December 2007, Wright Medical Group, Inc.; https:/ www.meddeviceonline.com/doc/wright-medical-group-launches-biological-grafti-0001

D36: Declaration by Prof. Burr, 14 November 2019

D53: Declaration by Prof. Lindgren, 5 October 2020

IV. Granted claim 1 is worded as follows:

A bone regenerative material comprising calcium sulfate, calcium phosphate, or demineralized bone matrix (DBM), or a combination thereof, for use in a method of treating a patient suffering from a degenerative bone condition that can be characterized by a loss of bone mineral density (BMD), the method comprising:
forming a void in a localized area of intact bone by clearing degenerated bone material and optionally removing a portion of the degenerated bone material; and
at least partially filling the formed void with a bone regenerative material that facilitates formation of new, non-degenerated bone material in the void.

V. The independent claims of auxiliary requests 1 and 2 underlying the Opposition Division's decision are worded as follows (additions and ~~deletions~~ are highlighted with respect to claim 1 as granted):

Auxiliary request 1:

A bone regenerative material comprising calcium sulfate, calcium phosphate, or demineralized bone matrix (DBM), or a combination thereof, for use in a method of treating a patient suffering from a degenerative bone condition that can be characterized by a loss of bone mineral density (BMD), the method comprising:
forming a void in a localized area of intact bone by clearing degenerated bone material and optionally

removing a portion of the degenerated bone material; and
at least partially filling the formed void with a bone regenerative material that facilitates formation of new, non-degenerated bone material into and throughout the filled void.

Auxiliary request 2:

A bone regenerative material comprising calcium sulfate, calcium phosphate, or demineralized bone matrix (DBM), or a combination thereof, for use in a method of treating a patient suffering from a degenerative bone condition that can be characterized by a loss of bone mineral density (BMD), the method comprising:
forming a channel into the interior of a localized area of intact bone,
using the channel as access, forming a void of dimensions greater than the channel in ~~a~~ the localized area of intact bone by clearing degenerated bone material and optionally removing a portion of the degenerated bone material,
at least partially filling the formed void with a bone regenerative material that facilitates formation of new, non-degenerated bone material in the void.

The wording of the independent claims of the other auxiliary requests does not need to be reproduced.

VI. In its decision the Opposition Division came to the conclusion that claim 1 of the granted patent could not benefit from the novelty exception in Article 54(5) EPC; the claim had to be interpreted as being directed to a material suitable to be used in the method defined

in the claim. The claim thus lacked novelty over D3 and a variety of other documents. The same applied to the independent claims of auxiliary requests 1, 2 and 7-9. The independent claims of auxiliary requests 3-6 and 10-13 lacked an inventive step under Article 56 EPC starting from D3 as closest state of the art.

VII. With its statement setting out the grounds of appeal and throughout the appeal proceedings the appellant submitted in particular that the independent claim of the granted patent was a claim directed to a substance or composition for use in a specific therapeutic method, the method being excluded from patentability under Article 53(c) EPC. The method defined a therapeutic treatment of humans suffering from bone degenerative diseases, in particular osteoporosis. Thus, novelty of the claim would have to be assessed under Article 54(5) EPC with the method steps being limiting features of the claim.

The appellant argued that novelty over D3 was provided by the feature "*non-degenerated bone material*" in the claim. The formation of non-degenerated bone material, i. e. bone material corresponding to a healthy rather than to an osteoporotic patient, was not disclosed in D3. Inventive step over D3 was provided likewise by this feature, or, in case of the claims of auxiliary request 2, by the method features of the claim.

VIII. With its statement of reply to the patentee's appeal and throughout the appeal proceedings the respondent (opponent) defended the Opposition Division's decision. The method steps in the claim were not limiting, the substances defined in the independent claims of the

granted patent as well as the auxiliary requests needed only to be suitable for the claimed method. For novelty to be assessed under Article 54(5) EPC the therapeutic application, i. e. the claimed use of the substance or composition, would have to provide a new technical teaching. The surgical steps of the claimed method were independent from the therapeutic effect of the substance and were not limiting features, but were unavoidable measures for obtaining the therapeutic effect.

In any case the granted claim lacked novelty over D3. D3 disclosed the substances and the method steps defined in the claim as well as the formation of new, non-degenerated bone. The feature *non-degenerated* did not imply any characteristics that were not disclosed in D3. The same held for claim 1 of auxiliary request 1.

The independent claim of auxiliary request 2 lacked an inventive step starting from D3. The claimed method differed from D3 in the surgical step which was however an alternative obvious already from D3 alone. The surgical step was moreover known for use in the treatment of bone degenerative diseases, e. g. from D34.

The grounds of opposition under Articles 100(b) and 100(c) EPC raised in opposition proceedings were not pursued anymore in appeal.

IX. Summons to oral proceedings were issued on 26 April 2022. On 12 December 2022 the Board issued a communication under Article 15(1) RPBA clarifying the points to be discussed and including a preliminary opinion on some of them. The Board's preliminary

opinion was that the pending claims had to be assessed under Article 54(5) EPC. Novelty and inventive step over D3 would have to be discussed during oral proceedings.

X. Oral proceedings took place on 20 April 2022. The parties final requests were the following:

The appellant (patent proprietor) requested that the decision under appeal be set aside and the opposition be rejected, i.e. the patent be maintained as granted.

As an auxiliary request the appellant requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of any one of auxiliary requests 1 to 13 underlying the appealed decision.

The respondent (opponent) requested the appeal to be dismissed.

XI. The decision was announced at the end of the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

2. Claim interpretation and novelty assessment under Article 54(5) EPC

2.1 In the impugned decision the Opposition Division came to the conclusion that claim 1 of the granted patent could not be read as a medical use claim under Article 54(5) EPC. The method defined in the claim did not involve a new technical teaching, as required by decision G 02/08, and was thus not novel. Therefore the claim had to be read as defining compositions suitable for this method. Since the materials defined in the claim are well-known (in fact, they are commercially available, see paragraph [0042] of the patent) the claim was then held to lack novelty over a variety of documents. Novelty was denied over D3, a document which the Opposition Division found to disclose the composition used in the method defined in the claim, but also over other documents which disclosed the compositions as such.

2.2 The appellant contested the Opposition Division's finding that the claim of the granted patent could not be interpreted according to the provisions of Article 54(5) EPC.

2.3 Article 54(5) EPC states that Articles 54(2) and (3) EPC do not exclude the patentability of a substance or composition for any specific use in a method referred to in Article 53(c) EPC, provided that this use is not comprised in the state of the art. Article 53(c) EPC states that no patent shall be granted in respect of methods in treatment for the human or animal body by surgery or therapy, or diagnostic methods practised on the human or animal body. This means that a claim to such a substance for use in such a method cannot be denied novelty only because the substance as such is already known.

2.4 Claim 1 of the patent defines a substance or composition, a *"material comprising calcium sulfate, calcium phosphate, or demineralized bone matrix (DBM)"* for a specific use in a method referred to in Article 53(c) EPC.

Whether the materials defined in the claim qualify as substance or composition in the sense of Articles 53(c) and 54(5) EPC was apparently discussed during oral proceedings before the Opposition Division. However, the impugned decision is silent on this issue; in its decision the Opposition Division did not contest that calcium sulfate and the other materials mentioned in the claim qualify as "*substance or composition*". The respondent did not refer to this point in its submissions either. Also the Board does not see any reason why calcium sulfate or the other materials mentioned in the claim should not qualify as "*substance or composition*" in the sense of Articles 53(c) and 54(5) EPC.

That the method defined in the claim is as such excluded from patentability under Article 53(c) EPC is self-evident. The method is for therapeutic treatment of the human body and, additionally, involves a surgical step.

2.5 Thus, claim 1 of the granted patent is clearly drafted *in the format provided for in Article 54(5) EPC*, generally called second medical use.

2.6 Article 54(5) EPC does not, as such, define any criteria to be applied for assessing whether a claim drafted according to the wording of the article is novel or not.

Whether the claim is novel over the prior art must be assessed in the usual way, i. e. by comparing the features of the claim, the nature of the substance or composition as well as the use and method steps, with the disclosure of the prior art.

The reference to G 2/08 made by the Opposition Division and the respondent, and the corresponding arguments of whether the method defined in the claim provides a new technical teaching may be important in this respect; these arguments are dealt with below.

2.7 The approach of the Opposition Division for assessment of novelty of this claim is based on the second part of Article 54(5) EPC, "*provided that such use is not comprised in the state of the art*". The novelty exception defined in Article 54(5) EPC only applies under this condition. Following this approach, in order to assess whether the novelty exception applies, it is first examined whether the specific use of the substance or composition defined in the claim is already known or not. If the use is already known, the claim cannot benefit from the novelty exception. The claim is not novel since the composition as such is already known.

2.8 The approach followed by the appellant is to read the claim in the format provided by Article 54(5) EPC. After assuring that the method defined in the claim falls under the exclusion of Article 53(c) EPC, the use and the method steps are considered as limiting features of the claim. Following this approach it then has to be examined whether the specific use of the substance or composition defined in the claim is novel or not. If this specific use is already known, the claim is not novel over the document disclosing the

specific use of the substance or composition defined in the claim.

2.9 In the end, and if applied correctly, both these approaches must lead to the same result. In both cases it has to be assessed whether the *specific use* of the substance or composition defined in the claim is already known or not. This *specific use* includes the method steps, because "*such use*" in the last phrase of Article 54(5) EPC refers to the "*specific use in a method*" of the previous phrase. If this *specific use* is already known, the claim is not novel and cannot be allowed.

2.10 The approach proposed by the appellant, i. e. reading the claim as it is drafted, assuring that the method falls under Article 53(c) EPC, then considering the use and method features as limiting and assessing whether the specific use defined by them is already known from the prior art is, in the Board's view, aligned with the wording of Article 54(5) EPC and follows its logic. The Article starts by stating that Articles 54(2)(3) shall not exclude the patentability of a substance or composition referred to in paragraph (4), thus implying that the substance or composition is already known. The article then continues to state that a specific use can provide novelty, in case it is not comprised in the state of the art. This approach is also the one generally used by EPO departments when assessing patentability of second medical use claims, and the Board will adhere to it in the present decision.

The approach taken by the Opposition Division appears to be prone to errors, in particular when the *specific use* includes various method steps to be taken into account, see points 3.2 and 5.4 below.

3. Novelty of claim 1 of the granted patent

3.1 Claim 1 of the granted patent defines a bone regenerative material for a specific use in the treatment of certain bone degenerative diseases, the most important one being osteoporosis. The use involves a method comprising two steps, namely creating a void in an intact bone, and filling the void with the bone regenerative material. The bone regenerative material comprises calcium sulfate, calcium phosphate, or demineralized bone matrix (DBM).

3.2 The respondent argued that the therapeutic use defined in the claim, i. e. the use of the bone grafting materials defined therein for the treatment of degenerative bone conditions, was already known as such. These materials were commercially available, see paragraph [0042] of the patent, and were, in the end, designed and marketed for this very purpose. This therapeutic use did not depend on the details of the surgical steps defined in the claim. In fact, the nature of the bone grafting material had no influence on the surgical step at all since this material was not used therein. The surgical step thus could not contribute to the novelty of the claimed therapeutic use of the materials, it rather was an unavoidable measure to achieve the desired therapeutic effect.

The Board does not agree. The claim defines a method for treating a patient suffering from a degenerative bone disease comprising two steps, firstly creating a void in an intact bone, and secondly filling the void with bone regenerative material. This is the "*specific use in a method*" referred to in Article 54(5) EPC, and

this use needs to be compared with the disclosure of the prior art. The surgical step of the present claim is clearly a part of the therapeutic method. Without the surgical step the bone grafting material could not deploy its therapeutic activity. The method defined in the present claim has to be assessed as a whole.

The respondent's approach to mentally split the method into different parts, associate to some of them an effect of the substance or composition defined in the claim as opposed to others, and ignore the ones which are not considered associated in this way is not valid in the present case already because here the surgical step is an integral part of the therapeutic method in which the substance is used. In view of Article 53(c) EPC referring to both therapeutic and surgical methods individually the Board has some doubts whether, in general, such an approach is at all justified, but this is not decisive in the present case.

Thus, the surgical method steps cannot be ignored when assessing novelty of the claim.

3.3 Novelty over D3/D33

The relevant disclosures of D3 and D33 are the same; in the following reference is made to D3.

3.3.1 D3 investigates the hypothesis that injection of a mixture of bone growth material comprising calcium sulfate and hydroxyapatite into the femur head of osteoporotic patients may lead to new bone growth, strengthen the bone and reduce the risk of subsequent fracture. A hole is drilled into the unfractured bone (see fig. 3), the material is applied and, after investigation of the hip of a patient who died a few

months after the intervention for unrelated causes, new bone formation was observed.

D3 states clinical trials to be under way, however, no results of any such trial are on file.

3.3.2 It was uncontested that the material used in D3 is according to the claim. It was likewise uncontested that the method used in D3 is according to the claim. The appellant defended novelty of the claim arguing that D3 failed to disclose the formation of "*non-degenerated bone material*" as required by the claim.

However, this feature cannot establish novelty of the claim for the reasons set out below.

3.3.3 D3 clearly discloses the formation of new bone material in the void. This is already stated in the title of the article. It is the idea of D3 to stimulate new bone formation by the injection of a bone graft material into the head, neck and trochanteric region of the hip in osteoporotic patients in order to strengthen the bone, see abstract. The formation of new bone, stimulated by the bone graft material introduced into the hole drilled into the head of the femur is also illustrated in figures 6-12 and figures 13-16 and in the corresponding passages in the description.

3.3.4 The appellant argued that the feature "*non-degenerated bone material*" in the claim not only required the formation of new bone material, but of new healthy bone, as opposed to the osteoporotic bone removed when creating the void. "*Non-degenerated*" did not just mean that the bone formed was new; in this case the feature would be meaningless, since *new* bone formation was already required as a separate feature of the claim.

With reference to the description of the patent, in particular paragraphs [0011], [0029] and [0030] the appellant argued that the term "*non-degenerated bone material*" related to bone material having a bone mineral density (BMD) corresponding to a 30-year old healthy individual, where this parameter is at its peak. This was shown in the patent in examples 4 and 5 and illustrated in figure 31. In the appellant's view the feature "*non-degenerated bone material*" would have to be interpreted in this way, since this interpretation is technically sensible and takes due account of the description, requirements that corresponded to those set by the jurisprudence of the Boards of Appeal, as summarized in the Case Law Book, 10th edition, II.A.6.3. There was no proof in D3 that the bone material formed there fulfilled these requirements.

3.3.5 This argumentation is not convincing. Independent from the question of whether, under which circumstances and how far the description may be used to interpret features of the claim, the description does not state that the only possible interpretation of "*non-degenerated bone material*" is the one proposed by the appellant.

According to par. [0011] the newly formed bone material is healthy bone material that exhibits characteristics which make the new material, "*in certain embodiments*", i. e. not necessarily, substantially similar to bone material in an average, 30-year old individual. The newly formed material *may specifically* have a density substantially identical to normal bone, see par. [0016]. Thus, these properties are disclosed as preferred, but not as required. The further passages in par [0029] and [0030] of the description do not use the

term "*non-degenerated*" at all, they refer to "*new bone material*", "*healthy bone material*" or "*normal bone material*" instead.

The description of the patent does not support the interpretation of "*non-degenerated bone material*" as exclusively referring to bone material corresponding to a 30-year old healthy subject, or bone material having certain physical characteristics relating to the BMD or T-score.

The feature "*new, non-degenerated bone material*" may as well be interpreted as relating to newly formed bone material not yet affected by degenerative processes, as brought forward by the respondent. In that sense the respondent's argument that newly formed bone material is, by definition, non-degenerated, has some merit.

3.3.6 Thus, the formation of new bone material disclosed in D3 anticipates the granted claim.

3.3.7 The parties submitted arguments and expert declarations (D27, D36, D9, D29, D11, D31, D53) relating to the question of whether D3 disclosed the formation of non-osteoporotic bone or not, or of whether a skilled person would have expected the formation of healthy or rather of osteoporotic bone if carrying out the treatment of D3. In view of the claim anyway covering the bone formation disclosed in D3 the Board does not need to take position on this issue.

3.4 The granted claim lacks novelty over the disclosure of D3 under Article 54(5) EPC.

Auxiliary request 1

4. Novelty (Article 54(5) EPC)

4.1 Claim 1 of auxiliary request 1 additionally requires that the bone regenerative material facilitates the formation of new, non-degenerated bone material into and throughout the filled void.

4.2 D3 discloses (page 342, right column) that in the investigated hip "*there was abundant new bone formation across the 4.5 mm drill hole*". Also in the left column on this page it is described that in the filled region of the drill hole new bone material is formed throughout the hole.

It is correct, as stressed by the appellant, that both these paragraphs continue to state that in the proximal uninjected part of the drill hole new bone grew only in a peripheral rim zone. However, the claim language does not require the entire void to be filled, it requires only that the bone regenerative material facilitates bone growth throughout the filled void. It does not require any bone growth in the unfilled part of the void.

4.3 Claim 1 of auxiliary request 1 also lacks novelty over D3.

Auxiliary request 2

5. Novelty (Article 54(5) EPC)

5.1 The method defined in claim 1 of auxiliary request 2 requires additional steps. In particular the claim defines that the method comprises:
forming a channel into the interior of a localized area of intact bone,
using the channel as access, forming a void of dimensions greater than the channel in ~~a~~ the localized area of intact bone by clearing degenerated bone material and optionally removing a portion of the degenerated bone material.

5.2 The Opposition Division held this claim to lack novelty, see point F.2 of the reasoning of its decision. It did not consider the method steps to provide a "new technical teaching". This terminology is taken from the Enlarged Board's decision G 02/08, as apparent from points E.3.1.18 and E.3.1.19 of the Opposition Division's reasoning.

5.3 Decision G 02/08 was mainly concerned with the question of whether a specific dosage regime could provide novelty under Article 54(5) EPC over a prior art document concerning the treatment of the same disease using the same active ingredient, but disclosing a different dosage regime, or none at all.

The passage the Opposition Division and the respondent referred to is in point 6.3 of the reasoning in G 02/08 and reads as follows:

"In particular, the claimed definition of the dosage regime must therefore not only be verbally different from what was described in the state of the art but also reflect a different technical teaching."

This passage refers to a new dosage regime but the essence of it, i. e. that for establishing novelty a new technical teaching is required, may well be applied to the present case.

5.4 As set out above, in a claim drafted according to Article 54(5) EPC the method steps must be taken into account when deciding on novelty. Requiring additional surgical steps clearly provides a new technical teaching compared to the disclosure of D3 already because additional physical actions must be undertaken. The method defined in the claim is thus not just verbally different from the method disclosed in D3, but differs in tangible, physical method steps.

D3 does not disclose forming a channel and using this channel as an access to form a void greater than the the channel in the bone. In D3 a hole is drilled, and nothing more, see figure 3.

5.5 Claim 1 of auxiliary request 2 is therefore novel over the method disclosed in D3. During oral proceedings before the Board the respondent confirmed that no other document disclosed the subject-matter of this claim either.

6. Inventive step (Article 56 EPC)

6.1 During oral proceedings before the Board both parties agreed on D3 as representing the closest state of the art.

6.2 The difference of the claim with respect to D3 lies in the method step. The claim requires not only that a channel is drilled into the bone, but that this channel

is used as an access to create a void of dimensions greater than the channel.

6.3 The parties disagreed on whether there is any effect associated with this feature. The appellant argued that since the void is bigger, more degenerated bone material can be removed, more bone regenerative material can be injected and the treatment is improved. The respondent argued that, firstly, the claim did not define any dimensions, so that it could not be concluded that the void was bigger. Secondly, a bigger void did not necessarily translate into a better treatment since it may become increasingly difficult to bridge the void with new bone material if the void gets too big.

6.4 The least ambitious technical problem that can be formulated starting from D3 is the provision of an alternative treatment of bone degenerative diseases.

This problem has been solved by the method defined in the claim which is characterized by first forming a channel into the interior of a localized area of intact bone, and then using the channel as access, forming a void of dimensions greater than the channel before introducing the bone graft material.

6.5 It remains to be decided whether starting from D3 such a method would have been obvious for a person skilled in the art.

6.5.1 The respondent argued that the claimed method was just an alternative method for forming a void. Such an alternative was well within the capabilities of a skilled person and already obvious from D3 alone. Moreover, the method was known from D34 which describes

the use of a device adapted for carrying out the surgical steps defined in the claim in the treatment of avascular necrosis (AVN) of the hip, likewise a bone degenerative disease.

6.5.2 These arguments are not convincing.

A skilled person, reading D3, would have had no reason to create a bigger void inside the bone, using the channel as an access. There is no indication anywhere in D3 that the drill hole alone could not accommodate the bone graft material injected into the bone, or that the amount of injected material was considered insufficient. On the contrary, it is indicated in figure 3 that the end of the drill hole remained unfilled after injection of the bone graft material. Thus, a skilled person would not see any need for further enlarging the void, using the channel as an access.

It is correct that D34 describes the method steps defined in the claim, in particular the drilling of a channel and the formation of a bigger void, using this channel as an access. However, D34 does not relate to osteoporotic patients, which are the patients treated in D3. Osteoporosis and avascular necrosis (AVN) may both be bone degenerative diseases, but this does not mean that treatment of these diseases is the same. The mechanisms causing the bone degeneration may be different. The respondent has not provided any arguments why a skilled person, starting from D3, would have turned to D34 and would have considered a surgical method used in patients suffering from avascular necrosis (AVN) of the hip as being applicable also to osteoporotic patients. That both conditions are bone

degenerative diseases is as such not a reason that the same surgical method would have been applied.

6.6 Therefore, the subject-matter defined in claim 1 of the second auxiliary request is not obviously derivable from the cited prior art.

7. In summary, claim 1 of the second auxiliary request defines a non-obvious method of treating bone degenerative diseases, correctly drafted as medical use claim in the format foreseen under Article 54(5) EPC.

No other objections remaining, the patent can be maintained on the basis of the claims of this request under Article 101(3)(a) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the opposition division with the order to maintain the patent on the basis of auxiliary request 2 as filed with letter dated 10 October 2019 (claims 1 to 17) and a description adapted thereto.

The Registrar: The Chairman:

C. Rodríguez Rodríguez A. Zellner

Decision electronically authenticated